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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,763	01/17/2006	Oleg Stenzel	274674US0PCT	9218
22850	7590	10/15/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
PARVINI, PEGAH				
ART UNIT		PAPER NUMBER		
1793				
NOTIFICATION DATE		DELIVERY MODE		
10/15/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/542,763

**Applicant(s)**

STENZEL ET AL.

**Examiner**

PEGAH PARVINI

**Art Unit**

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) 10-15, 18 and 22-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 16-17, and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Election/Restrictions***

Newly submitted claims 23-25 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 23 and 24 are directed to methods for preparing elastomeric mixture and pneumatic tires, etc. whereas previously claimed claims were directed to a precipitated silica; furthermore, claim 25 is directed to a battery separator, an antiblocking agent, a matting agent for inks and paints and more wherein none is directed to vulcanizable rubber mixtures as originally presented in claim 21.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 23-25 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

#### ***Specification***

Applicants' amendment to the specification by deleting the duplicate paragraph in page 7 is acknowledged.

#### ***Double Patenting***

The rejection of claims 1-9, 16-17 and 21 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8, 18, 19, 23, and 30 of copending Application No. 10/542,850 is proper and stands.

***Claim Rejections - 35 USC § 103***

The rejection of claims 1-4, 6-9, 16-17 and 21 under Title 35 U.S.C. 103(a) as being unpatentable over Esch et al. in view of Boyer et al. as generally presented in the previous Office Action is proper and stands.

It is noted that claims 19-20 are canceled.

The rejection of claims 1-9, 16-17 and 21 under Title 35 U.S.C. 103(a) as being unpatentable over Uhrandt et al. in view of Boyer et al. as generally presented in the previous Office Action is proper and stands.

It is noted that claims 19-20 are canceled.

***Response to Amendment***

Applicants' amendment to claims 2-9 and 16-17, filed June 27, 2008, pages 3-7 is acknowledged. However, said amendments are not sufficient to place the application in condition for allowance.

Applicants' amendment to claims by canceling claims 19-20 in the reply filed June 27, 2008 is acknowledged. As such the rejection under 112 second paragraph of said claims is withdrawn.

***Response to Arguments***

Applicants' arguments filed June 27, 2008 have been fully considered but they are not persuasive.

The Declaration under 37 CFR 1.132 filed June 27, 2008 is insufficient to overcome the rejection of claims 1-9, 16-17 and 21 based upon Esch et al. in view of Boyer et al. as set forth in the last Office action because: The Declaration is not commensurate with the scope of the claims, specially the independent claim 1 because no measurement on the claimed characteristics of the precipitated silica as recited in claim 1 (such as BET, CTAB, DBP, etc.) has been presented; furthermore, only one example of only one reference (Uhrlandt et al. was not included in the declaration) has been conducted and compared with only one example of the instant Application. There is insufficient result to establish unexpected results for the instant invention.

Applicants' argument with respect to silanol group of precipitated silica is not found persuasive.

Applicants have argued that the ratio of the absolute number of silanol groups to the BET surface area is taken and normalized, and the normalized number is present in the claims of the invention and is a value of 0.150 to 0.280 ml/(5m<sup>2</sup>).

The Examiner, respectfully, submits that the ratio of sears number to BET as had been presented previously, falls within the claimed range of said ratio as recited in claim 1; it is to be noted that a reference is not considered only in view of its examples, but a reference should be

given weight as a whole. Thus, Applicants' attempt to show that the  $V_2/BET$  ratio of examples 1 and 2 of Esch et al. are outside of the claimed range is not found persuasive. Additionally, although Applicants attempted to show that Esch et al. do not teach a normalized  $V_2$  factor, from the remarks and tables presented in the reply filed June 27, 2008, it is apparent that normalized value refers to a ratio of  $V_2/BET$ .

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PEGAH PARVINI whose telephone number is (571)272-2639. The examiner can normally be reached on Monday to Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. P./  
Examiner, Art Unit 1793

/Michael A Marcheschi/  
Primary Examiner, Art Unit 1793